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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/705,559	
	Filing Date	11/02/2000	
	First Named Inventor	Joseph A. McCluskey	
	Art Unit	3624	
	Examiner Name	Kyle, Charles R.	
Total Number of Pages in This Submission	19	Attorney Docket Number	31083.04US1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: McCluskey et al. )  
Serial No. 09/705,559 ) Examiner: Kyle, Charles R.  
Filed: November 2, 2000 ) Art Unit: 3624  
Title: System And Method For ) Attny Docket: 31083.04US1  
Electronically Sourcing )  
Products )

REPLY BRIEF

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Dear Sir:

In accordance with 37 C.F.R. § 1.193, the Appellants hereby reply to the  
Examiner's Answer. Appellants' remarks commence on Page 2 of this paper.

This Reply Brief is being filed in triplicate

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1<sup>st</sup> day of December, 2004.

By: Ranni Matar  
Ranni Matar

I. The Rejections of Claims 1-3, 6-7, and 9-13 under 35 USC § 101

In the Examiner's Answer, the Examiner set forth that the Appellants have failed to address the rejection of claims 1-3, 6-7, and 9-13 under 35 U.S.C. § 101 - set forth in the Office Action of May 28, 2004 - and, as such, have demonstrated "an acquiescence with these grounds of rejection."

In response, the Appellants' respectfully submit that this rejection was not addressed in the filed Appeal Brief for the reason that, during a phone conference with the Examiner prior to responding to the Office Action of May 28, 2004, the rejection under 35 U.S.C. § 101 was discussed with the Examiner, the Examiner agreed that the rejection under 35 U.S.C. § 101 was in error, and the Examiner agreed to withdraw these grounds of rejection. (*See* Appellants' Response to Office Action submitted on June 23, 2004). It was understood by the Appellants' that this rejection was in fact withdrawn since the Appellants' summary of the interview, included as part of the Response to Office Action submitted on June 23, 2004, was not indicated to be in error by the Examiner in the subsequently issued Advisory Action. (*See* Advisory Action dated August 10, 2004). Nevertheless, for the sake of completeness, the Appellants take this opportunity to state that the Appellants continue to believe that the rejection under 35 U.S.C. § 101 was made in error and, to the extent that it was not previously withdrawn, must be withdrawn as a result of this appeal.

As discussed with the Examiner, the subject matter set forth in claims 1-3, 6-7, and 9-13 fully comply with the requirements of 35 U.S.C. § 101. For example, method claims 1-3 and 6-7 set forth a process that produces a "useful, concrete, and tangible" result, i.e., it sets forth a method for using a computer system for the purpose of gathering

product information in response to an electronic request and the gathered product information is returned to a customer in an electronic message and, if need be, added to a electronic database to thereby augment product information that is already maintained within the database. Thus, the method set forth in claim 1-3 and 6-7, which includes interrelated structures that performs interrelated functions and which defines more than a process that consists solely of the manipulation of an abstract idea, complies with the requirements of 35 U.S.C. § 101. With respect to apparatus claims 9-13, while the forgoing remarks apply, it is also noted that it is well settled that claims directed to a computer-readable storage device, e.g., a floppy disk or CD, containing a set of instructions for performing steps fulfills the requirements of 35 U.S.C. § 101. *See In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

For at least these reasons, it is respectfully requested that the rejection based upon 35 U.S.C. § 101 be withdrawn.

## II. The Examiner's Comments Concerning The Rejection under 35 USC § 103

As set forth in the Appellants' Appeal Brief, the rejection of the claims fails to set forth a *prima facie* case of obviousness and, furthermore, reflects that the Examiner has impermissibly distilled the claimed invention down to its "thrust or gist" without giving due consideration to each and every element set forth in the claims.

As has been acknowledged in the Examiner's Answer, the Appellants assertion that Talib discloses a "closed system" is correct. (*See Examiner's Answer, Page 7*).

While the Examiner has asserted that the "Appellants fail to recognize that the closed system of Talib...is but one embodiment," the Appellants respectfully submit that Talib describes no embodiments that might be said to include the elements of the claims that

have been acknowledged by the Examiner to be missing from the “closed system” disclosed by Talib. In this regard, while Talib describes in the Background that traditional “open ended” search methods existed that may return null search results (*See* Para. 29 of Talib) and that general Internet searching existed (*See* Paras. 071-081 of Talib), Talib does not disclose or suggest that these prior, known systems included the claimed “if the electronic database does not contain information for the product, automatically sending an electronic request to perform a search outside of the electronic database to gather information for the product” or the claimed “returning the gathered information to the customer in an electronic message and adding the gathered information to the electronic database.” Therefore, since the preferred embodiment of Talib, which has been acknowledged to be directed to a “closed system,” i.e., one in which all searches (initial and subsequent) are performed using taxonomy labels which have been provided to products already in an electronic catalog, and any other system described in Talib, such as the “open ended” systems described in the Background of Talib, fail to disclose at least the aforementioned claim elements, there is no manner in which Talib can be read as disclosing “the invention substantially as claimed” as was set forth in the rejection of the claims. Since no assertion has been made that those claim elements that are clearly missing from Talib are disclosed, taught, or suggested by Liddy, which they are not, the combination of Talib and Liddy cannot be said to include each and every element of the claims as is required to maintain a rejection under 35 U.S.C. § 103.

As previously discussed, Liddy discloses nothing more than a Web crawling system for retrieving uncategorized documents from vast numbers of data repositories spread over the Internet. While Liddy may teach the desirability of providing a “greater

search area,” as has been asserted in the rejection of the claims, nothing from Liddy can be said to disclose, teach, or suggest the desirability of modifying Talib to include those claim elements which are clearly missing from Talib. More particularly, it cannot be said that Liddy suggests the desirability of modifying Talib to include those missing claim elements since the system of Liddy likewise fails to disclose those claim elements that are missing from Talib. Since it is required that Liddy suggest more than the desirability of providing a “greater search area,” i.e., it is required that Liddy suggest modifying Talib to include all of those claim elements that are missing from Talib, the disclosure within Liddy, which omits the requisite elements and, therefore, any suggestion to include those elements in Talib, fails to be sufficient to support a *prima facie* case of obviousness.

Finally, it is again respectfully submitted that, to modify Talib according to the teachings of Liddy to thereby provide a “greater search area” would impermissibly change the principle of operation of Talib. In this regard, as has been acknowledged in the Examiner’s Answer, the system of Talib is directed to a “closed system,” i.e., a system in which all searching is limited to a stringent taxonomy which is utilized to categorize all possible search results. Meanwhile, the elements of Liddy which the Examiner proposes to use to modify Talib to provide a “greater search area” are Web crawlers which are designed to retrieve uncategorized documents. Since this espoused modification would change the principle of operation of Talib from a “closed system” to an “open system” that would encompass searching outside of the stringent taxonomy required by Talib, the espoused modification is not sufficient to render the claims *prima facie* obvious and the rejection of the claims must be withdrawn.

All previously submitted remarks and arguments are hereby incorporated by reference in their entirety.

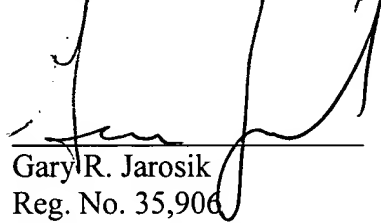
III. Conclusion

It is respectfully submitted that, when the claims are considered *as a whole*, the claims are not rendered obvious by the combination of Talib and Liddy. As such, it is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Date: December 1, 2004

By:

Respectfully Submitted;



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